



# UNITED STATES PATENT AND TRADEMARK OFFICE

*ink*  
UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,854	09/28/2001	Joel Andre	034299-350	7039

7590 02/11/2004  
ROBERT E. KREBS  
THELEN REID & PRIEST LLP  
P.O. BOX 640640  
SAN JOSE, CA 95164-0640

EXAMINER

DEL SOLE, JOSEPH S

ART UNIT	PAPER NUMBER
----------	--------------

1722

DATE MAILED: 02/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/937,854

Applicant(s)

ANDRE, JOEL

Examiner

Joseph S. Del Sole

Art Unit

1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 9/29/03, 12/8/03 and 1/29/04.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 4-7, 9-11, 13-17, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4-7, 9-11, 14, 15, 17 and 19 is/are allowed.
- 6) ☒ Claim(s) 20 is/are rejected.
- 7) ☒ Claim(s) 13 and 16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 16 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 16 fails to further the parent claims because it does not structurally limit the apparatus. It merely recites an intended use of the apparatus, namely applying external pressure. This process limitation does not further limit the structure of the apparatus. The Examiner notes that the Applicant's remark's indicate that claim 16 was cancelled, however the actual claims submitted indicate that claim 16 remains and claim 18 has been cancelled. The Examiner believes that claim 18 has been cancelled accidentally; to remedy these two issues, the Examiner would suggest keeping claim 18 cancelled (it cannot be revived) and rewriting claim 16 to read as claim 18 read originally.

### ***Double Patenting***

2. Claim 13 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 5. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Claims 5 and 13, while always claiming identical subject matter, were originally dependent on different claims. Since they have

now been both amended to be dependent on claim 4, they are now identical. Claim 13 should be deleted.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by McCarville et al (5,709,893).

McCarville et al teach a shaping tool comprising a rigid mold (Fig 12), and shaping means (Fig 12, #72 and #74) suitable for pushing a part blank into contact with the rigid mold; the tooling being characterized in that the rigid mold is formed of several elements (Fig 12, #160, #162, #130 and #50) without any connection between them, holding means (Fig 12, #72/74) being provided to keep the elements normally in contact with each other so as to define a cavity inside; wherein the mould has at least one central element (Fig 12, #50) and two end elements (Fig 12, #160 and #162), the central element having abutment surface for the end elements and the holding means urging the end elements against the abutment surfaces, independently of the shaping means.

Regarding the limitation of claim 20: "while enabling the said elements... to separate during a cooling phase following polymerization of the blank", this limitation fails to further limit the claim because it does not further define the claim structurally.

***Allowable Subject Matter***

5. Claims 4-7, 9-11, 14-15, 17 and 19 are allowed.
6. The following is an examiner's statement of reasons for allowance: the prior art of record fails to teach or suggest the subject matter as set forth in the Office action of 5/30/03.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

***Response to Arguments***

7. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

The Examiner acknowledges that the objections to the specification and claims 3, 5, 8 and 13 have been overcome by either amendment or cancellation. However, as discussed above, claim 16 remains objected to because it has not been cancelled as indicated and claim 13 is newly objected to because it is a duplicate of allowed claim 5.

The Examiner acknowledges that the rejections over claims 1-3, 6, 10, 11, 15 and 16 have been overcome by either amendment to or cancellation of claims.

***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

Art Unit: 1722

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Correspondence***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Joseph S. Del Sole whose telephone number is (571) 272-1130. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wanda Walker, can be reached at (571) 272-1151. The official fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306 for both non-after finals and for after finals.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from the either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on the access to the Private PAIR system, contact the Electronic Business Center (EBC) at 886-217-9197 (toll-free).

*Joseph S. Del Sole*

J.S.D.  
February 6, 2004

*Robert Davis*  
ROBERT DAVIS  
PRIMARY EXAMINER  
GROUP 4300-1700

*2/6/04*